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In re Application of
GROEGER, et al.
U.S. Application No.: 10/593,567
PCT No.: PCT/EP05/02933
Int. Filing Date: 18 March 2005
Priority Date: 22 March 2004
Attorney Docket No.: 294227US0X PCT
For: PROCESS FOR PREPARING OPTICALLY
ACTIVE AMINO ACIDS USING A WHOLE-
CELL CATALYST

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's petition to accept the present national stage application without the signature of joint inventor Werner Hummel filed 21 August 2007 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 18 March 2005, applicant filed international application PCT/EP05/02933, which claimed a priority date of 22 March 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 06 October 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 September 2006.

On 20 September 2006, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee and a preliminary amendment.

On 21 June 2007, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 21 August 2007, applicant filed the present petition under 37 CFR 1.47.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (1) and (4).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

While applicant has provided a first hand account of the mailing of papers to Professor Hummel signed by Ms. Wissel, as well as, proof of delivery; it appears from the statement and exhibits that the inventor was only provided with a declaration for signature and not a complete set of application papers.

Regarding item (3), applicant has not provided the last known address of Professor Hummel.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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